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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Yoshiaki Nozawa

Serial No.: 09/522,608

Group Art Unit: 2697

Filed: March 10, 2000

Examiner: Thomas E. Volper

For: STATISTIC MULTIPLEX TRANSMISSION SYSTEM

Honorable Commissioner of Patents
Alexandria, VA 22313-1450**PETITION TO WITHDRAW FINALITY OF REJECTION AS PREMATURE
UNDER 37 C.F.R. § 1.181**

Sir:

Applicant respectfully petitions under 37 C.F.R. § 1.181 that the finality of Patent Application S/N 09/522,608: "STATISTIC MULTIPLEX TRANSMISSION SYSTEM" be withdrawn as premature under the guidelines of M.P.E.P. § 706.07(a). this guideline states: "...second or any subsequent actions on the merits shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims..." (emphasis added).

Applicant respectfully submits that, contrary to the Examiner's position in the latest Office Action dated March 10, 2004, one of ordinary skill in the art would readily recognize that the claims amendments in the Amendment Under 37 C.F.R. § 1.111 filed on May 28, 2003, were not all directed to the purpose of overcoming the rejection of the Office Action dated March 3, 2003. Applicant respectfully submits

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that no claim amendments were necessary to overcome this rejection and that the amendments were clearly not so intended.

Indeed, while the claims were amended in the Amendment filed on May 28, 2003, the amendments merely were editorial in nature and should not have changed the scope of these claims.

In the Office Action dated March 10, 2004, the Examiner has withdrawn the previous rejections of claims 2-6 and has raised a new ground of rejection based on newly cited prior art. Applicant respectfully submits that the new ground of rejection was not necessitated by Applicant's amendment filed on May 28, 2003.

Indeed, the Examiner does not even allege that Applicant's amendments filed on May 28, 2003 necessitated the new grounds of rejection, but instead, states that "this action is deemed final" because the "arguments with regard to claim 1... failed to overcome the 35 U.S.C. § 103(a) rejection" based on Zhang et al. (U.S. Patent No. 6,181,711), Duault et al. (U.S. Patent No. 6,108,336) and Jones et al. (U.S. Patent No. 6,307,836) (see Office Action dated March 10, 2004 at page 5, numbered paragraph 6).

Moreover, in the following paragraph, the Examiner specifically states that a "new ground" of rejection is applied to claims 2-6 (see Office Action dated March 10, 2004 at page 5, numbered paragraph 7).

Thus, Applicant respectfully submits that the traversal arguments submitted with the Amendment filed on May 28, 2003 were successful in overcoming the

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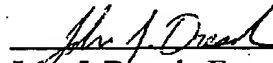
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rejection of claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over Zhang et al. in view of Duault et al. and Jones et al., and further in view of Rao (U.S. Patent No. 5,506,844) and the rejection of claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Zhang et al., Duault et al., Jones et al., Rao, and further in view of Fichou et al. (U.S. Patent No. 6,072,773). These rejections were not maintained in the Office Action dated March 10, 2004, and thus, have been withdrawn.

For at least the reasons outlined above, Applicant respectfully petitions that the finality of the rejections for the above-identified Application be withdrawn.

Respectfully Submitted,

Date: May 10, 2004



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CERTIFICATE OF TRANSMISSION

I certify that I transmitted via facsimile to (703) 872-9306 the enclosed Petition to Withdraw Finality under 37 C.F.R. § 1.181 to Examiner Thomas E. Volper, on May 10, 2004.


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